

Serial No. 10/663,889
Amendment Filed May 15, 2006
Reply to Office Action Dated December 15, 2005

REMARKS

The Official Action dated December 15, 2005, has been carefully considered. Applicants wish to thank the Examiner for his indication of the allowance of claims 4, 5, 7 and 9-10. The changes presented herein, taken with the following remarks, are believed sufficient to place the present application in condition for allowance. Claim 26 has been cancelled. Claim 27 has been added. Claims 1, 4 and 15 have been amended. Claims 1-25 and 27 remain in the application for consideration. Reconsideration is respectfully requested.

In the Official Action, the drawings were objected to because no reference was made in the specification regarding reference number "120." In light of the amendment to the specification Applicants believe this objection has been overcome and respectfully request reconsideration.

Applicants note that the specification was also objected to because of the bolding and underlining of section headings. It is Applicants' understanding that these objections were in light of processing concerns at the Patent Office and that such issues have been resolved and, as such, Applicants believe that no changes to the section headings are necessary. Therefore, Applicants respectfully request that this objection be reconsidered.

The abstract was also objected to in the present Official Action for being over 150 words. In light of the present amendment to the abstract, Applicants believe the objection has been overcome and respectfully request reconsideration.

In the Official Action, claims 1-3, 11, 13-19 and 21-26 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting over the claims of co-pending Application No. 10/894,488 (the '488 application), alone or in view of Teson (U.S. patent No. 5,222,640) or Wilson (U.S. Patent No. 4,230,246). These rejections are traversed on the basis that the claims of this application are patentably distinguishable from the claims of the cited patent applications and patents.

Serial No. 10/663,889
Amendment Filed May 15, 2006
Reply to Office Action Dated December 15, 2005

In determining whether any claim in an application merely defines an obvious variation of an invention disclosed and claimed in another co-pending application one compares the claims of each application because the disclosure of the co-pending application may not be used as prior art. See *In re Vogel*, 422 F.2d 438, 441 (C.C.P.A. 1970). Here, claims 1-3, 11, 13-19 and 21-25 of the present application are not rendered obvious in light of the claims provided in the '488 application, alone or in view of Teson or Wilson. References relied upon to support a rejection under 35 U.S.C. §103 must provide an enabling disclosure. *In re Payne*, 203 U.S.P.Q. 245 (C.C.P.A. 1979). The claims of the present application are directed to a vehicle having a support structure for a spare tire, while the claims of the '488 application are directed to a retention system. Independent claim 1 recites a vehicle which includes a shell, a support member and a retention member. Particularly, the retention member is fixedly attached to the shell interfacing a side section of the support member and configured to permit sliding movement of the support member along the movement path with respect to the shell. The claims of the '488 application do not teach or suggest such a retention member. Rather the claims of the '488 application describe a retention system which includes a compartment, tray, at least one removable interconnecting member and at least one guide member. These limitations of the '488 application do not teach or suggest a retention member as presently recited in independent claim 1. Claim 1 does not recite a removable interconnecting member or a guide member as recited in the '488 application. The guide member as claimed in the '488 application is configured to selectively interface the back portion of the tray which will impede movement of the tray along a movement path, while the retention member recited in independent claim 1 permits sliding movement of the support member along the movement path. Thus, the claims of the '488 application do not render independent claim 1, or those dependent thereon, obvious. Moreover, Teson or Wilson fail to teach or suggest such a retention member as recited in independent claim 1.

Serial No. 10/663,889
Amendment Filed May 15, 2006
Reply to Office Action Dated December 15, 2005

Therefore, independent claim 1 is patentably distinct from the claims of the '488 application, alone or in view of Teson or Wilson. As such, Applicants believe the provisional obviousness-type double patenting rejection has been overcome and therefore respectfully request reconsideration.

Independent claim 15 of the present application recites a vehicle having a shell and a support member where the shell and support member have a cooperative locking configuration for substantially inhibiting movement of the support member relative to the shell along the movement path when the support member is at the first position, wherein a portion of the cooperative locking configuration provided by the support member is further configured for substantially inhibiting sliding movement of the support member relative to the shell along the movement path when the support member is at the second position. Rather the claims of the '488 application describe a retention system which includes a compartment, tray, at least one removable interconnecting member and at least one guide member. These limitations of the '488 application do not teach or suggest a cooperative locking configuration as presently recited in independent claim 15. For example, claim 15 does not recite a removable interconnecting member as recited in the '488 application. Rather, the cooperative locking configuration as recited in claim 15 substantially inhibits sliding movement of the support member relative to the shell along the movement path when the support member is at the first position, wherein a portion of the cooperative locking configuration provided by the support member is further configured for substantially inhibiting sliding movement of the support member relative to the shell along the movement path when the support member is at the second position. The '488 application claims include at least one removable interconnecting member configured to selectively interface with both the tray and the chamber for substantially preventing movement in a first direction. However, claim 15 provides that the cooperative locking configuration substantially inhibits

Serial No. 10/663,889
Amendment Filed May 15, 2006
Reply to Office Action Dated December 15, 2005

sliding movement of the support member when the support member is at the first position and when a portion of the cooperative locking configuration provided by the support member is at the second position. Effectively, the cooperative locking configuration substantially inhibits sliding movement when the support member is disposed within the shell and when the support member is at least partially disposed outside the shell. Moreover, the '488 application teaches at least one guide member, the presently claimed vehicle under claim 15 does not recite such a guide member. Thus, the claims of the '488 application do not render independent claim 15, or those dependent thereon, obvious. Moreover, Teson or Wilson fail to teach or suggest such a cooperative locking configuration as recited in independent claim 15. Therefore, independent claim 15 is patentably distinct from the claims of the '488 application, alone or in view of Teson or Wilson and, as such, Applicants believe the provisional obviousness-type double patenting rejection has been overcome and therefore respectfully request reconsideration.

Claims 1 and 15 have been amended to indicate that the support member is internally contained within the vehicle, i.e., it is within the structural perimeter of the vehicle. Support for the claim amendments can be found in the specification and drawings (for example, see Figs. 1, 6A and 6B). It is believed that these changes do not involve any introduction of new matter, and thereby entry is believed to be in order and is respectfully requested.

In the Official Action, claims 1, 3, 6, 8, 11, 14-16, 20, 21 and 26 were rejected under 35 U.S.C. § 102(b) as being anticipated by Fukushima et al (U.S. Patent Publication No. 2001/0052712). The Examiner asserts that Fukushima et al disclose a vehicle having a support structure including a shell (floor panel 14) attached to the vehicle, the shell includes first and second end portions and a bottom portion extending at least partially between the first and second end portions (Fig. 6); a support member (trunk case 1) being slidably positioned above the bottom portion and movable back and forth along a movement path

Serial No. 10/663,889
Amendment Filed May 15, 2006
Reply to Office Action Dated December 15, 2005

from a first position (Fig. 1) in which the support member is substantially disposed within the shell and a second position (Fig. 2); and a retention member (biasing members 15 or locking mechanism 26) fixedly attached to the shell and permitting sliding movement of the support member along the movement path. Moreover, the Examiner contends that Fukushima et al disclose a locking configuration (locking mechanism 26 and strikers 28) for substantially inhibiting sliding movement of the support member relative to the shell along the movement path when the support member is selectively positioned relative to the shell.

However, as will be set forth in detail below, it is submitted that the vehicles as defined by claims 1, 3, 6, 8, 11, 14-16, 20 and 21 are not anticipated by the teachings of Fukushima et al. Accordingly, this rejection is traversed and reconsideration is respectfully requested.

As defined by claim 1, from which claims 2-3 and 6-14 depend, a vehicle having a support structure for a spare tire includes a shell, a support member and a retention member. The shell is attached to the vehicle. The shell includes first and second end portions and a bottom portion extending at least partially between the first and second end portions. The shell is at least partially defining a spare tire storage chamber and includes an opening providing access to the storage chamber. The opening is adjacent to the first end portion. The support member is internally contained within the vehicle and adapted to support a spare tire. The support member is slidably positioned above the bottom portion and movable back and forth along a movement path from a first position in which the support member is substantially disposed within the shell and a second position in which the support member is at least partially disposed outside the shell. The support member includes a lower interface surface for directly contacting an upper interface surface of the bottom portion of the shell in sliding engagement as the support member is moved along the movement path. The retention member is fixedly attached to the shell. The retention member interfaces a side section of the

Serial No. 10/663,889
Amendment Filed May 15, 2006
Reply to Office Action Dated December 15, 2005

support member. The retention member is configured to permit sliding movement of the support member along the movement path with respect to the shell and is operative to limit movement of the support member with respect to the shell in at least one direction substantially perpendicular to the movement path.

Independent claim 15, from which claims 16-25 and 27 depend, recites a vehicle having a support structure for a spare tire including a shell, support member and a cooperative locking configuration. The shell is attached to the vehicle. The shell includes first and second end portions and a bottom portion extending at least partially between the first and second end portions. The shell is at least partially defining a spare tire storage chamber and including an opening providing access to the storage chamber. The opening is adjacent to the first end portion. The support member is internally contained within the vehicle and adapted to support a spare tire. The support member is slidably positioned above the bottom portion and movable back and forth along a movement path from a first position in which the support member is substantially disposed within the shell and a second position in which the support member is at least partially disposed outside the shell. The support member includes a lower interface surface for directly contacting an upper interface surface of the bottom portion of the shell in sliding engagement as the support member is moved along the movement path. The support member and the shell have a cooperative locking configuration for substantially inhibiting sliding movement of the support member relative to the shell along the movement path when the support member is at the first position. A portion of the cooperative locking configuration provided by the support member is further configured for substantially inhibiting sliding movement of the support member relative to the shell along the movement path when the support member is at the second position.

Fukushima et al disclose a rear luggage compartment structure for a vehicle body (abstract). Particularly, Fukushima et al teach that the truck case when stored can be locked

Serial No. 10/663,889
Amendment Filed May 15, 2006
Reply to Office Action Dated December 15, 2005

by a keyless locking mechanism to prevent the trunk case from sliding and that when in the stored position the back portion of the trunk case is biased by biasing members (see Figs. 3, 6, 8 and 9).

Rejection for anticipation or lack of novelty requires, as the first step in the query, that all elements of the claimed invention be described in single reference. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989), cert. denied, 493 U.S.P.Q.853 (1989). With respect to independent claim 1, Applicants are unable to find any teaching or disclosure by Fukushima et al of a vehicle having a support structure internally contained within the vehicle. Fukushima et al teach accessing a trunk case for the storage of luggage from a location outside of the rear of the vehicle such that the trunk case is not internally contained within the vehicle when accessed (see Figs. 1 and 2 of Fukushima et al). However, the present inventive vehicles have a support member capable of moving between a first position and a second position where the support member when partially disposed outside of the shell is still internally contained within the vehicle. As such, the vehicles as recited in independent claims 1 and 15, and those claims depending from them, are not taught or disclosed by Fukushima et al. It is therefore submitted, that the presently claimed vehicles are not anticipated by Fukushima et al, whereby the rejection under 35 U.S.C. §102 has been overcome. Reconsideration is respectfully requested.

In the Official Action, claims 12-13 and 24-25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Fukushima et al II (U.S. Patent No. 6,474,715) in view of Kennedy (U.S. Patent No. 4,676,415). Claims 12-13 and 24-25 depend from independent claims 1 and 15 respectively.

However, as will be set forth in detail below, it is submitted that the vehicles as defined by claims 12-13 and 24-25 are nonobvious and patentably distinguishable over

Serial No. 10/663,889
Amendment Filed May 15, 2006
Reply to Office Action Dated December 15, 2005

Fukushima et al II in view of Kennedy et al. Accordingly, this rejection is traversed and reconsideration is respectfully requested.

Kennedy generally disclose a combined spare tire support and rear step bumper assembly (abstract). Kennedy also teach locking bolts inserted through the bumper of the vehicle to lock the spare tire support, such that the tire support does not slide (see Figs. 2 and 6).

As noted above, Fukushima et al (the published application for Fukushima et al II) does not teach the support member being internally contained within the vehicle. Fukushima et al II does not rectify this deficiency. The failures of Fukushima et al II are also not remedied by the combination with Kennedy. Rather, Kennedy teaches extending a spare tire support from a stored position underneath the truck bed to an extended position where the spare tire support is exposed outside of the rear end of the vehicle (see Fig. 2). Again, there is no teaching of having the support member internally contained within the vehicle when the support member is at least partially disposed outside of the shell when the support member is at an extended position. In view of the failure of Fukushima et al II and Kennedy to teach or suggest having the support member being internally contained within the vehicle, as recited in independent claims 1 and 15, Fukushima et al II and Kennedy do not support a rejection of claims 12-13 and 24-25 under 35 U.S.C. § 103. Applicant therefore submits that the 35 U.S.C. § 103 rejection of the presently claimed retention systems of claims 12-13 and 24-25 over Fukushima et al II in view of Kennedy has been overcome. Reconsideration is respectfully requested.

It is therefore submitted, that the presently claimed retention systems are nonobvious over Fukushima et al II in view of Kennedy, whereby the rejection under 35 U.S.C. §103 has been overcome. Reconsideration is respectfully requested.

Serial No. 10/663,889
Amendment Filed May 15, 2006
Reply to Office Action Dated December 15, 2005

It is believed that the above remarks provide a complete response to the objections and rejections under 35 U.S.C. §§ 102, 103, and the judicially created doctrine of obviousness-type double patenting, and as such, place the present application having claims 1-25 and 27 in condition for allowance. Reconsideration and an early allowance are requested.

Respectfully submitted,

By:

Clayton L. Kuhnell

Clayton L. Kuhnell
Registration No. 48,691
Attorney for Applicant(s)
Dinsmore & Shohl LLP
1900 Chemed Center
255 East Fifth Street
Cincinnati, Ohio 45202
(513) 977-8377

1244759v1